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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,752	02/09/2004	Robert J. Hendrickson	WRGI 20.264	8714
26304 7590 01/23/2008 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585				
EXAMINER				
SZA/NA, MARK T				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/775,752

**Applicant(s)**

HENDRICKSON, ROBERT J.

**Examiner**

MARK SZAJNA

**Art Unit**

4194

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/02)
- Paper No(s)/Mail Date 2-9-04
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Objections***

Claims 9-24 are objected to because of the following informalities. The claims are misnumbered. There are two claims that are numbered 9. As such, every claim after the second claim 9 is misnumbered and each dependent claim that follows refers back to an inappropriately numbered claim. In addition, claim 1 has a minor grammatical error in the phrase "while the customer is present in the POS outlet". Instead, "in the POS outlet" should read "at the POS outlet". Finally, in claim 22 (original claim 21), the word "store" should be "stored". Appropriate correction is required.

### ***Claim Rejections - 35 USC §102***

The following is a quotation of the second paragraph of 35 U.S.C. §102 which forms the basis for all obviousness rejections set forth in the office action:

(b) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5, 6, 7, 8, 9, 10 (originally the 2<sup>nd</sup> claim 9), 11 (originally claim 10), 12 (originally claim 11), 13 (originally 12), 16 (originally 15), 17 (originally 16), 18 (originally 17), and 19 (originally 18), 20 (originally claim 19), 21 (originally claim 20), 22 (originally claim 21), 23 (originally claim 22), and 24 (originally claim 23) are rejected under 35 U.S.C. §102 (b) as being unpatentable over *Deaton et al.* (US 6,292,786).

Concerning claim 1, *Deaton* teaches a method for making a promotional offer by a seller to a customer in a point-of-sale (POS) outlet, the method comprising the steps of:

- a) recognizing the customer as being present in the POS outlet (Col.2, line 19);
- b) determining an identity of the recognized customer (Col.2, line 19);
- c) selecting the promotional offer from an offer inventory (Col.2, line 20-21),
- d) the offer inventory including at least one of a product offer and a service offer of the seller (Col.2, lines 20-21);
- e) and presenting the promotional offer to the customer while the customer is present in the POS outlet (Col.2, lines 22-24);
- f) wherein the promotional offer is selected based on at least one characteristic associated with the customer identity (Col.2, lines 22-24).

Concerning claim 2, *Deaton* teaches a method wherein the customer identity is determined using individual identification means coupled to a customer database (Col. 2, lines 25-35). Furthermore, as to claim 8, *Deaton* discloses a method of claim 2, further comprising the step of retrieving customer information associated with the customer identity from the database (Col. 2, lines 30-35).

As to claim 5, *Deaton* discloses a method wherein the customer identity includes an individual customer identity. This includes identifying particular customers at the point-of-sale through the use of customer identification numbers, the contents of a customer's smart card, and/or credit card numbers (Col. 4, lines 25-32).

Concerning claims 6 and 7, *Deaton* teaches a method wherein the customer identity includes at least one of a plurality of predetermined customer groups. The plurality of predetermined customer groups are defined according to at least one of product types offered by the seller, service types offered by the seller, purchase levels of the customer and other customers, purchase frequencies of the customer and the other customers, and term of relationship between seller and customer and seller and other customers. This includes offering incentives to customers that is independent of the purchases of a particular customer in a current transaction (Col. 10, lines 20-21). The types of groups disclosed include a customer's total spending levels, customer's level of spending on a particular manufacturer's products, and a customer's spending on a particular product class or department within the POS outlet (Col. 10, lines 33-42, lines 56-61).

Concerning claims 9, 10 (originally the 2<sup>nd</sup> claim 9), 11 (originally claim 10), and 12 (originally claim 11), *Deaton* teaches a method wherein the retrieved customer information includes at least one of customer purchase information and customer interest information and the at least one identified characteristic is determined based on the retrieved customer information. In addition, *Deaton* teaches a method wherein the at least one identified characteristic is determined based on customer information relating to activities undertaken by the customer in the POS outlet and the customer information relates to at least one of the areas of the POS outlet visited by the customer and purchases made in the POS outlet by the customer. The disclosed method of retrieving customer information includes customers past purchasing history and/or

purchases made in a current transaction (Col. 4, lines 50-54). Furthermore, the customer incentives may be provided by a manufacturer that relate to a recent purchase or non-purchase, which would occur within the POS outlet (Col. 4, lines 57-60).

Concerning claim 13 (originally claim 12), *Deaton* teaches the method of claim 13 (originally claim 12) wherein the customer information relating to activities undertaken by the customer in the POS outlet is stored in the customer database (Col. 2, lines 30-35). See discussion of claims 2 and 8 above.

As to claims 16 (originally 15), 17 (originally 16), 18 (originally 17), and 19 (originally 18), *Deaton* discloses the method of claim 8, wherein the retrieved customer information includes information indicating one or more preferred offer presentation modes of the customer and the preferred offer presentation modes are selected from the group consisting of offer presentations by a POS outlet host, in-outlet electronic means, and personal electronic means. The in-outlet means are selected from the group including kiosks, interactive product displays and electronic signage and the personal electronic means are selected from the group including pagers, personal digital assistants, and cellular telephones. In particular, *Deaton* discloses an in-outlet method of displaying data to customers that is relative to a group of incentives, which may be transmitted to a customer at the point-of-sale through the use of a kiosk (Col. 15, lines 4-7). In addition, *Deaton* also discloses a personal method of presenting incentives to customers through the use of an electronic mail message that is directed to a customer (Col. 13, lines 47-50). An electronic mail message could be sent to a

Art Unit: 4194

personal computer, personal digital assistant (PDA), cellular telephone or any personal electronic device that is capable of receiving email messages.

Concerning claims 20 (originally 19), 21 (originally 20), 23 (originally 22), and 24 (originally 23), *Deaton* discloses the method of claim 2, further comprising the step of tracking interactions between the customer and the seller occurring subsequent to the presenting step, wherein the interactions tracked include at least one of product sales between the seller and the customer and service sales between the seller and the customer. *Deaton* also discloses this method wherein customer information relating to the tracked interactions is stored in the customer database and the promotional offer is evaluated as a function of customer information relating to the tracked interactions. This includes the aforementioned list in the previous paragraph found within Col. 10, lines 33-4. In particular the final item would necessitate interactions that occur within the POS outlet and that are stored in the remote computer system.

As to claim 21 (originally claim 20), *Deaton* discloses the method of claim 22 wherein customer information relating to the tracked interactions is stored in the customer database (Col. 2, lines 30-35). See discussion of claims 2 and 8 above.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 14 (originally 13), 15 (originally 14), and 25 (originally 24), are rejected under 35 U.S.C. 103(a) as being unpatentable over *Deaton et al* (US 6,292,786) in view of *Deaton et al. (US 6,611,811)*.

As to claim 3 and 4, *Deaton et al. (US 6,292,786)* discloses the invention substantially as claimed. See the discussion of claims 1 and 2 above. *Deaton ('786)* does not a method wherein the individual identification means is selected from the group consisting of image recognition means, voice recognition means, and cord recognition means. However, *Deaton et al. (US 6,611,811)* discloses a method of identifying a customer through the use of information contained on a customer identity card, reading information from a credit card, image recognition, and/or voice recognition (Col. 138, lines 48-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of *Deaton ('786)* with the teachings of *Deaton ('811)*. The motivation to combine would have been to allow for more convenient and efficient means of identification of customers within the POS outlet.

Concerning claims 14 (originally 13), 15 (originally 14), and 25 (originally 24), *Deaton et al. (US 6,292,786)* discloses the invention substantially as claimed. See the discussion of claims 2 and 8 above. *Deaton ('786)* does not disclose the method of claim 8 wherein the selecting step further comprises a step of evaluating a plurality of promotional offers in the inventory as a function of an offer cost and an anticipated return on investment (ROI) and the anticipated ROI is evaluated based on the retrieved



customer information. However, *Bibelnieks et al.* teaches a method of analyzing customers based upon historical criteria and analyzing a promotional plan or a group of promotion events implemented or to be implemented over a particular time period in order to determine the effect of each promotion event on the other promotion events in the promotional plan. Based on this analysis, it would be possible to determine the optimal promotion stream, which is a specific subset of the promotional plan to be sent to customers or a group of similar customers, so as to maximize the ROI of the promotional plan as a whole. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of *Deaton* ('786) with the teachings of *Bibelnieks*. The motivation to combine would have been to minimize the cost of each promotional offer and maximize the return on investment of each promotional offer.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Szajna whose telephone number is 571-270-3615. The examiner can normally be reached on Monday through Friday 9:30 am to 7:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4194

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Szajna/  
Examiner, Art Unit 4194  
12 – 17 – 07

/Charles R. Kyle/

Supervisory Patent Examiner, Art Unit 4194